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DOCKET NO: ISA-064.01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Badley, et al.
Serial No:	09/920,306
Filed:	August 2, 2001
For:	Peptides Capable of Functioning as Mimotypes for Hormonal Analytes
Examiner:	David J. Venci
Art Unit:	1641

**CERTIFICATE OF FIRST CLASS MAILING**

I hereby certify that this "*Response and Amendment*" is being deposited with the United States Postal Service as First Class Mail, in an envelope addressed to: Mail Stop: Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450, on May 19, 2006.

  
Merlin Aubourg

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO RESTRICTION REQUIREMENT**

This communication is a response to the Restriction Requirement in the above-identified application, mailed April 19, 2006. No fee is believed to be due in connection with this submission. Applicants hereby authorize the Commissioner to charge the any required fee to Deposit Account Number **06-1448, Reference ISA-064.01.**

Applicants provisionally elect ***Group I, claims 1-13, with traverse***, for prosecution on the merits. Applicants' grounds for traversal are set forth below.

It is the position of the Examiner that Groups I and III are unrelated, because the allegedly different inventions allegedly are independent chemical entities and allegedly require separate searches in the patent and non-patent literature. The Applicants

respectfully assert that simultaneous examination of Groups I and III would not place an undue burden on the Examiner, because the claims of the two allegedly different inventions are directed to polypeptides and the polynucleic acids encoding those polypeptides, respectively. A search and examination of a DNA encoding a polypeptide would also necessarily entail a search and examination of the polypeptide sequence, and vice versa, posing no serious burden on the Examiner. See M.P.E.P. §803 ("If the search and examination of an entire application can be made without serious burden, the [E]xaminer must examine it on the merits, even though it includes claims to independent or distinct inventions."). **Therefore, the Applicants respectfully request that the Examiner modify the instant Restriction Requirement, examining Groups I and III in the instant application.**

In addition to restriction among the groups of claims, the Examiner has further required restriction to one peptide sequence from claims 3, 5, and 6 under 35 U.S.C. § 121.

It is Applicants' position that while a species election may be proper among the various peptides for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable, an election under 35 U.S.C. §121 is improper since the claims are linked by a generic linking claim (see M.P.E.P. §809.02). The Examiner's restriction improperly limits a clearly described chemical genus, the base structure and substituents of which are readily ascertained by one of skill in the art, based on the claim and supporting definitions and description in the specification. Such generic structures are commonly examined in the chemical arts. At the very most, applicants should be restricted to a single species *for search purposes only*.

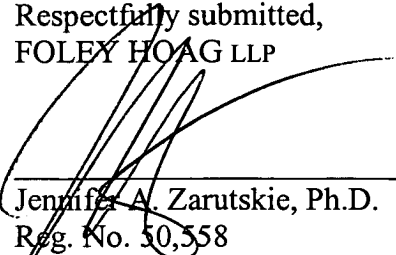
If a species election is required, Applicants further provisionally elect **claim 6, with traverse and for search purposes only**. It is Applicants' understanding that the search will be extended to the remaining species upon a finding of allowability. Applicants request that the Examiner reconsider and remove this second restriction requirement among the various peptide species.

Applicants hereby reserve the right to petition the Commissioner to review the restriction requirement if this restriction requirement is made final.

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If a telephone conversation with Applicant's Attorney would expedite prosecution of the application, the Examiner is urged to contact Applicant's Attorney.

Respectfully submitted,  
FOLEY HOAG LLP



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